

## **REMARKS**

Applicant respectfully requests further examination and reconsideration in view of the amendments above and the remarks set forth below. Claims 1-32 were previously pending in this application. In response to the Restriction Requirement, Claims 13-32 are withdrawn. In the Office Action, Claims 1-12 are rejected. By the above amendments, Claims 1 and 7 are amended. Accordingly, Claims 1-12 are currently pending.

### **Restriction Requirement**

Within the Office Action, the claims are restricted to one invention under 35 U.S.C. 121. Specifically, it is indicated that Group 1 directed to Claims 1-12, Group 2 directed to Claims 13-19, Group 3 directed to Claims 20-27, and Group 4 directed to claims 28-32, are directed to distinct inventions.

The Applicant elects Group 1 directed to Claims 1-12 without traverse. Therefore, the Applicant elects examination to Claims 1-12. Claims 13-32 are withdrawn.

The Applicant expressly reserves the right to file one or more divisional applications directed toward the non-elected groups.

### **Claim Rejections under 35 U.S.C. § 102 and 35 U.S.C. § 103**

Within the Office Action, Claims 1-12 stand rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. Patent No. 6,120,029 issued to Carmichael et al. (hereinafter referred to as "Carmichael"). The Applicant respectfully traverses these rejections.

The board game of the present invention includes a game board divided into an inner play area and an outer play area. One or more outer game pieces move within the outer play area, and a plurality of inner game pieces move within the inner play area. Certain ones of the inner game pieces, called Human Being game pieces, function according to one of two modes of operation.

Each of the modes of operation define a separate and distinct functionality for the corresponding Human Being game pieces. Preferably, a first mode of operation is referred to as a “take mode”, and a second mode of operation is referred to as a “give mode.” Human Being game pieces functioning in the take mode attempt to remove other non-Human Being inner game pieces from the inner play area. Human Being game pieces functioning in the give mode attempt to restore previously removed inner game pieces. Human Being game pieces in the give mode also attempt to position themselves, along with other certain inner game pieces, in a particular configuration that will win the game.

The game is played as a series of rounds, each round includes first a player functioning in the take mode and then another player functioning in the give mode. To begin each round, an outer game piece is moved within the outer play area. The position of the outer game piece after it is moved determines the functionality of the Human Being game pieces within the inner play area. Preferably, the Human Being game piece that is positioned closest to the outer game piece is determined to be the Human Being game piece functioning in the take mode. The remaining Human Being game pieces then function in the give mode. Since the outer game piece is moved to start each round, the mode of operation, or function, of each of the Human Being game pieces may change with each round.

Within the Office Action, it is stated that “rules/methods for playing, such as how movement or position of one playing piece in the outer array changes the movement of pieces in the inner array do not further add any limitation to the apparatus in the claims.” The Applicant respectfully disagrees with this conclusion. As described above, a position of the outer game piece in the outer play area determines not a movement of the inner game pieces, as stated in the Office Action, but instead a function of certain inner game pieces, specifically the Human Being game pieces. The Human Being game pieces function according to two separate modes of operation, the take mode and the give mode. Each mode defines a separate and distinct function for the Human Being game pieces.

According to MPEP 2173.05(g) Functional Limitations, “[a] functional limitation is an

attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms...A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step.”

Clearly a position of the outer game piece determines a functionality of a portion of the inner game pieces, specifically the Human Being game pieces. The functionality is determined by what mode of operation the Human Being game pieces are operating in, which varies from round to round. Therefore, the determined mode of operation defines each Human Being game piece for “what it does”, as stated in MPEP 2173.05(g). The mode of operation is specifically determined by a position of an outer game piece within the outer play area. As such, the position of the outer game piece within the outer play area is a functional limitation of the board game in general, and a functional limitation of the plurality of game pieces in particular.

Carmichael teaches an education game for teaching chess. The education game includes a chess board 20 including two sets of chess pieces, white and black, which operate according to the well known rules of chess. As such, each chess piece within the chess board 20 operates according to a fixed mode of operation. In other words, each chess piece is defined by a fixed functionality according to the standard rules of chess. The operation of each chess piece does not change. Positioning or movement of a chess piece through the course of play does not alter its functionality. Similarly, movement and position of playing marker 12 within a game track 30, which surrounds the chess board 20, also does not alter the functionality of any of the chess pieces within the chess board 20. As such, Carmichael does not teach that the functionality, or mode of operation, of certain game pieces (chess pieces) within an inner play area (chess board 20) is determined by a position of a game piece (playing marker 12) within an outer play area (game track 30).

The amended independent Claim 1 is directed to a board game comprising a plurality of game pieces and a game board. The game board includes an inner play area wherein a first portion of the plurality of game pieces are positioned within the inner play area, and an outer play area wherein a second portion of the plurality of game pieces are positioned within the outer play area. A first position of at least one of the game pieces within the outer play area moves to a second position and a mode of operation of one or more of the first portion of game pieces within the inner play area is determined by the second position of the at least one game piece within the outer play area. As discussed above, Carmichael does not teach that the mode of operation of certain game pieces within an inner play area is determined by a position of a game piece within an outer play area. For at least these reasons, the amended independent Claim 1 is allowable over the teachings of Carmichael.

Claims 2-6 depend upon the amended independent Claim 1. As discussed above, the amended independent Claim 1 is allowable over the teachings of Carmichael. Accordingly, Claims 2-6 are allowable as being dependent upon an allowable base claim, and are now in condition for allowance.

The amended independent Claim 7 is directed to a board game comprising a game board and a plurality of pieces. The plurality of game pieces include a plurality of inner game pieces associated with the inner play area, each inner game piece including a corresponding functionality. The plurality of game pieces also includes at least one outer game piece associated with the outer play area, wherein a position of the outer game piece within the outer play area determines a mode of operation of one or more of the plurality of inner game pieces within the inner play area. As discussed above, Carmichael does not teach that the mode of operation of certain game pieces within an inner play area is determined by a position of a game piece within an outer play area. For at least these reasons, the amended independent Claim 7 is allowable over the teachings of Carmichael.

Claims 8-12 depend upon the amended independent Claim 7. As discussed above, the amended independent Claim 7 is allowable over the teachings of Carmichael. Accordingly,

Claims 8-12 are allowable as being dependent upon an allowable base claim, and are now in condition for allowance.

For the reasons given above, the Applicant respectfully submits that Claims 1-12 are now in a condition for allowance, and allowance at an early date would be appreciated. Should the Examiner have any questions or comments, he is encouraged to call the undersigned at (408) 530-9700 to discuss the same so that any outstanding issues can be expeditiously resolved.

Respectfully submitted,  
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**CERTIFICATE OF MAILING (37 CFR § 1.8(a))**

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Date: 4-18-05 By: Nicole Reed